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| 10/694,145 | 10/27/2003 | Barbara Horn | 200314366-1 | 3276 |

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

| EXAMINER | |
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| VO, ANH T N | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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JERRY.SHORMA@HP.COM
ipa.mail@hp.com
jessica.l.fusek@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* BARBARA HORN, KEITH KIRBY, MEHRGAN KHAVARI, RIO T. RIVAS, DEANNA J. BERGSTROM, SHEN BUSWELL, and GERALD G. TRUNK

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Appeal 2009-2058
Application 10/694,145
Technology Center 2800

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Decided:[1] May 11, 2009

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Before EDWARD C. KIMLIN, BRADLEY R. GARRIS, and JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 6 and 34-38. We

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

have jurisdiction under 35 U.S.C. § 6(b).

Claim 6 is illustrative:

6. A fluid ejecting device comprising:

a substrate having a feature formed by a first process that removes substrate material from the substrate, the feature extending into the substrate and within the substrate along an axis, where a cross-section of the feature taken transverse the axis has an upper terminus proximate a first substrate surface, the upper terminus having a first profile; and,

where the upper terminus is formed to have a second profile different from the first profile by a second different process that removes additional substrate material from the substrate and also removes debris created by the first substrate removal process and where the feature comprises a fluid-handling slot.

The Examiner relies upon the following references in the rejection of the appealed claims (Ans. 3):

| | | |
|---|---|---|
| Baughman | 5,608,436 | Mar. 04, 1997 |
| Boyle | 2002/0170891 A1 | Nov. 21, 2002 |
| Hall | 6,902,867 B2 | Jun. 07, 2005 |

Appealed claim 6 stands rejected under 35 U.S.C. § 102(a) as being anticipated by Boyle. Appealed claims 6 and 34-38 stand rejected under 35 U.S.C. § 102 as being anticipated by either Baughman or Hall.

We have thoroughly reviewed each of Appellants' arguments for patentability. However, we find no error in the Examiner's determination that the applied references describe the claimed subject matter within the meaning of § 102. Accordingly, we will sustain the Examiner's rejections for essentially those reasons expressed in the Answer.

Appellants have not refuted the Examiner's factual determination that each of the three cited references describes the presently claimed fluid ejecting device comprising a substrate having a feature extending into the substrate and within the substrate along an axis, where a cross-section of the feature taken transverse the axis has an upper terminus proximate a first substrate surface, the upper terminus having a first profile, where the upper terminus has a second profile different from the first profile, and where the feature comprises a fluid-handling slot. Appellants contend that the references do not teach or suggest a second different process that removes additional substrate material from the substrate to form an upper terminus having a second profile different from a first profile wherein the second process also removes debris created by the removal process on the first substrate (*see* Br. 9, last para.). Appellants maintain that "[t]he first process and second process recited in claim 6 impart distinctive structural characteristics to the final product" (Br. 10, penultimate para.).

As pointed out by the Examiner, the claims on appeal are drafted in product-by-process format and, therefore, certain principles of patent jurisprudence apply. In particular, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either § 102 or § 103 of the statute is eminently fair and acceptable. As a practical matter, the USPTO is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. *In re Brown*, 459 F.2d 531, 535 (CCPA 1972). Also, if the product in a product-by-process claim is the same as or obvious from a product of the prior art,

the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). In such cases, the applicant shoulders the burden of establishing with objective evidence or compelling reasoning that the claimed product is structurally different than and patentably distinct from the prior art product.

In the present case, the Examiner has properly assessed that Appellants' arguments are focused upon an asserted difference in the process of making the claimed product and the process used by the applied references. However, Appellants' arguments are totally devoid in identifying any structural distinction between fluid ejecting devices and microelectro mechanical systems within the scope of the appealed claims and those devices and systems fairly disclosed by the applied references. For instance, although Appellants assert that the claimed first and second processes impart distinctive structural characteristics to the final product, Appellants fail to particularize precisely what such differences are over the prior art products. Consequently, in the absence of Appellants identification of specific structural differences between the claimed and prior art products, the prima facie case of unpatentability set forth by the Examiner stands unrebutted.

In conclusion, based on the foregoing and the reasons well stated by the Examiner, the Examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2008).

AFFIRMED

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HEWLETT PACKARD COMPANY
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FORT COLLINS, CO 80527-2400